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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/690,438

10/21/2003

Minh Tran

OP-07-1

3709

21394 7590 03/28/2008
ARTHROCARE CORPORATION
7500 Rialto Boulevard
Building Two, Suite 100
Austin, TX 78735-8532

EXAMINER

PHILOGENE, PEDRO

ART UNIT

PAPER NUMBER

3733

NOTIFICATION DATE

DELIVERY MODE

03/28/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

intel_prop@arthrocare.com

| | | | |
|------------------------------|--------------------------------------|-----------------------------------|--|
| Office Action Summary | Application No. 10/690,438 | Applicant(s) TRAN, MINH | |
| | Examiner Pedro Philogene | Art Unit 3733 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-12,16 and 18-25 is/are pending in the application.
- 4a) Of the above claim(s) 2,4,19 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,6-12,16,18 and 21-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/23/08</u> . | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/22/08 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16,22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harvin et al. (5,618,314) in view of Stivala (4,210,148).

With respect to claims 16, Harvin et al disclose a bone anchor device (5) for attaching connective tissue to bone comprising an anchor body (10) comprising two surfaces, (as best seen in FIG.1) and made from a material that is compatible with the human body a suture retaining aperture (30) disposed in the anchor body and extending through both of the of the surfaces, a bone locking structure (60) radially extending from the anchor body and adapted to affix the device in a bone tunnel; as best seen in FIG.7, a length of suturing material (350) extending through the suture retaining aperture, wherein the suturing material is a material that is compatible with the

human and suitable for implantation in the human body wherein the length of suturing material is looped about the anchor body, as best seen in FIG.7. The bone locking structure has a first orientation and a second orientation different than the first orientation; as best seen in FIGS.14,15, wherein the bone locking structure comprises a deployable member comprising a first shape and a second deployed shape different than the first shape; as best seen in FIGS.14,15.

It is noted that Harvin et al did not teach of a body comprising two flat planar faces and a suturing material looped about the anchor body and contacts substantial portions of both of the two faces and wherein a first portion of the length of suturing material is looped over a second portion of the length of suturing material, the second portion of which lies in contacting engagement with one of the surfaces of the anchor body; as claimed by applicant. However, in similar art, Stivala provides the evidence of the use of a of a suture anchor having two faces and wherein a first portion of the length of suturing material is looped over a second portion of the length of suturing material, the second portion of which lies in contacting engagement with one of the surfaces of the anchor body to prevent rupturing of the wound during healing.

Therefore, given the teaching of Stivala, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Harvin et al, as taught by Stivala, to prevent rupturing of the wound during healing.

Claims 1,3, 6-12, 18, 21, are rejected under 35 U.S.C. 103(a) as being unpatentable over Harvin et al. (5,618,314) in view of Stivala (4,210,148) in view of Papay et al. (6,517,542).

It is noted that the above combination of references discloses all the limitations, except for suture retaining apertures extend in a direction substantially transverse to the longitudinal axis; as claimed by applicant. However, in a similar art, Papay et al provide the evidence of the use of an anchor having retaining apertures that extend in a direction substantially transverse to the longitudinal axis to enhance the osteogenesis process, thereby locking the anchor in place over time to provide an exceptionally secure connection.

Therefore, given the teaching of Papay et al, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Harvin, as taught by Papay et al to enhance the osteogenesis process, thereby locking the anchor in place over time to provide an exceptionally secure connection.

Response to Arguments

Applicant's arguments, see remarks, filed 1/22/08, with respect to the rejection(s) of claim(s) 1,3,6-12, 16, 18, 21-25 under 102/103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Papay et al/ Harwin et al/Stivala.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

| | | |
|-----------|---------|---------------------|
| 6,045,573 | 4-2000 | Wenstrom, Jr. et al |
| 5,258,016 | 11-1993 | Dipoto et al. |

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5,219,359

6-1993

McQuilkin et al

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Pedro Philogene/
Primary Examiner, Art Unit 3733
March 19, 2008

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